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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/845,589	04/30/2001	Dale F. McIntyre	82466RLO	2441

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10/17/2002

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EXAMINER

CARTER, MONICA SMITH

ART UNIT

PAPER NUMBER

3722

DATE MAILED: 10/17/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

09/845,589

Applicant(s)

MCINTYRE ET AL.

Examiner

Monica S. Carter

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 July 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Terminal Disclaimer

1. The terminal disclaimer filed on July 30, 2002 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of Application No. 09/825,453 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 3-6 and 10-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Huang et al. (5,897,220) in view of Attenberg (5,623,581).

Huang et al. disclose a method of arranging a series of at least two visual images of different characteristics of the same image comprising using a digital image to produce a series of digital images of different characteristics and forming the images on a single medium (see figure 2 and col. 4, lines 39-58).

Huang et al. disclose the claimed invention except for cutting out the images and fixing the cut out images on a page.

Attenberg discloses a digital image reproduced on a single sheet wherein the sheet is scored along lines (58, 60) defining areas so that individual images (52) can be peeled

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off the sheet (54) and adhered to a surface. Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify Huang's invention to include cutting and fixing the images to a surface, as taught by Attenberg, for displaying the images in a decorative manner.

Regarding claim 3, Huang et al., as modified by Attenberg, discloses the characteristic including different sizes (see figure 2 of Huang et al.).

Regarding claim 4, see the above rejections to claim 1.

Regarding claim 5, Huang et al., as modified by Attenberg, discloses the images being photographic images.

Regarding claim 6, Huang et al., as modified by Attenberg, discloses the cut out images being fixed by using an adhesive (see Attenberg, col. 2, lines 26-29).

Regarding claim 10-13, see the above rejections.

Regarding claim 14, it is inherent that other images, such as backgrounds, borders, etc. could be arranged on the page before or after fixing the images on the page.

4. Claims 2, 7-9 and 15-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Huang et al. in view of Attenberg, as used above, and further in view of Morag (6,324,545).

Huang et al., as modified by Attenberg, discloses the claimed invention except for an instruction sheet providing information including text and images in digital format over a communication channel to a service provider.

Morag discloses a method of generating a personalized photo album comprising using digital images transmitted over a service provider. The images and instructions are transmitted by digital means such as over the Internet. The service provider prints the images on a single sheet of paper. Once the album is complete, an electronic proof copy may be sent to the customer for approval having computer-readable instructions for viewing and/or printing of the album. Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify Huang's invention to include instructions, as taught by Morag, for providing information related to the album between the customer and the service provider.

Response to Arguments

5. Applicant's arguments with respect to claims 1-24 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Attenberg (5,913,019).

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monica S. Carter whose telephone number is (703) 305-0305. The examiner can normally be reached on Monday-Thursday (8:00 AM - 5:30 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrea L. Wellington can be reached on (703) 308-2159. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9302 for regular communications and (703) 872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

A handwritten signature in black ink, reading "Monica S. Carter". The signature is written in a cursive style with a large, stylized "M" and "C".

Monica S. Carter
Examiner
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October 16, 2002